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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,425	09/07/2004	Achim Weber	IP 2107-253	9293
2352 7590 05/22/2009 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER YU, MELANIE J				
ART UNIT		PAPER NUMBER		
1641				
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05/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/500,425

**Applicant(s)**

WEBER ET AL.

**Examiner**

MELANIE YU

**Art Unit**

1641

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 11-65, 78, 80, 82, 84, 86, 88, 90 and 92-96 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 13-22, 24-26, 29-31, 35-46 and 90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims withdrawn from consideration are 5, 11, 12, 23, 27, 28, 32-34, 47-65, 78, 80, 82, 84, 86, 88 and 92-96.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 31 March 2009 has been entered.

### ***Status of the Claims***

2. Claims 1-7, 11-65, 78, 80, 82, 84, 86, 88, 90 and 92-96 are pending in this application.

Claims 5, 11, 12, 23, 27, 28, 32-34, 47-65, 78, 80, 82, 84, 86, 88 and 92-96 are withdrawn.

Claims 1-4, 6, 7, 13-22, 24-26, 29-31, 35-46 and 90 are examined on the merits.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 1-4, 6, 7, 13-17, 19-22, 24-26, 29-31, 35-46 and 90 are rejected under 35 U.S.C. 103(a) as being obvious over Mirkin et al. (US 2002/0127574) in view of Kotov (US 7,045,087).

Regarding claims 1 and 90, Mirkin et al. teach an element comprising a carrier with a surface (transparent substrate, Fig. 13B) and at least one microstructure on the carrier surface (single microstructure shown, Fig. 13B, bottom two figures), wherein the microstructure consists of individual components in the form of nanoparticles (circular elements are gold nanoparticles, Fig. 13B), which have molecule specific detection sites with one or more first functional groups (DNA absorbed onto particles, Fig. 13B) to which biologically functioning or active molecules bind to the first functional groups can be bound in a directional manner and thus make possible the addressability of the microstructure (analyte DNA strand hybridized to first functional group, Fig. 13B), and wherein between the surface of the carrier and the microstructure at least one layer of a bonding agent that is a self assembled monolayer based on thiol is provided to ensure permanent adherence of the nanoparticles (nanoparticles bonded to the surface through thiol monolayer, Fig. 13B).

Mirkin fails to teach the bonding agent being a plasma layer with charged chemically reactive groups.

Kotov teaches a functional element comprising: a carrier with a surface (col. 5, lines 18-27) and at least one microstructure on the carrier surface, where the microstructure consists of individual components in the form of nanoparticles (second solution deposits nanoparticles on the substrate, col. 5, lines 42-48) and a bonding agent between the surface of the carrier and the nanoparticles, wherein the bonding agent is a plasma layer with charged chemically reactive groups (first solution deposits positively charged polyelectrolyte layer on the substrate, which is a plasma layer, and is between the substrate and the nanoparticles, col. 5, lines 32-41; plasma layer has chemically charged reactive groups, col. 3, lines 49-59), and is provided to ensure permanent adherence of the nanoparticles (nanoparticles are adsorbed onto the surface and are therefore permanently adhered, col. 3, lines 31-41; film of plasma and nanoparticles remains intact as a unitary structure, col. 2, lines 13-15), in order to provide a freestanding film that permits incorporation of biological compounds.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include in the element of Mirkin et al., a bonding agent of a plasma layer with charged chemically reactive groups between the microstructure and the carrier surface as taught by Kotov, in order to take advantage of overcompensation of surface charges and provide increased adsorption of nanoparticles on the substrate.

Regarding claims 2-4, Mirkin et al. teach the microstructure having a diameter of 375  $\mu\text{m}$  on the planar, glass slides (surface is a glass slide, which is planar, par. 133;

diameter of spot a length parameter and is within the recited range of 10 nm to 999  $\mu\text{m}$ , par. 383).

With respect to claim 6, Mirkin et al. teach the surface of the carrier having a layer of a chemical compound that prevents nonspecific attachment of biological molecules to the carrier surface (par. 372).

Regarding claim 7, Mirkin et al. teach a layer of a bonding agent arranged between the carrier surface and the microstructure (nanoparticles bonded to the surface through thiol monolayer, Fig. 13B).

With respect to claims 13-15, Mirkin et al. teach the nanoparticles comprise a core and a surface that has the molecule specific recognition sites covalently bound to the nanoparticles (oligonucleotides with a functional group that binds to the nanoparticles is bound to the nanoparticles, par. 61) and biologically active molecules bound to the molecule-specific recognition sites (oligonucleotides that are recognition oligonucleotides are attached to the biologically active molecules on the nanoparticles, par. 62).

Regarding claims 16 and 17, Mirkin et al. teach that the molecules are bound while preserving their biological activity (par. 7 and 62) and the bound molecules are nucleic acids (par. 7).

With respect to claims 19 and 20, Mirkin et al. teach the molecule specific recognition sites comprising one or more first functional groups and the bound molecules comprise complementary second functional groups that bind the first

functional groups (par. 173) and the function group being an amino or aldehyde (par. 180).

Regarding claims 21 and 41-46 are drawn to methods of making the functional element and does not provide additional structural limitations. Mirkin et al. teach the limitations recited in claim 1 and therefore has the same structure as a functional element produced by the methods recited in claims 21 and 41-46.

With respect to claims 22, 24-26 and 29, Mirkin et al. teach the first functional groups bound to the surface of the nanoparticles via a spacer (par. 242) and the core of the nanoparticles being polystyrene (par. 180) and having a diameter of 5-150 nm (par. 107), which falls within the recited range of 5 to 500 nm.

Regarding claims 30, 31 and 35, Mirkin et al. teach the core or the bound molecule having an anchored fluorescence marker (oligonucleotide or nanoparticles labeled with fluorescent marker, par. 178).

With respect to claims 36-38, Mirkin et al. teach further molecules bound to the bound molecules (par. 323) and the microstructure consisting of a single (par. 104) or several nanoparticles layers (par. 83).

Regarding claims 39 and 40, Mirkin et al. teach that within several microstructures, the nanoparticles making up the microstructures have different molecule specific recognition sites that are arranged on the carrier surface and various molecules are bound to the microstructures (different nucleic acids, par. 173).



2. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mirkin et al. (US 2002/0127574) in view of Kotov (US 7,045,087) further in view of Mirkin et al. (US 2002/0132371).

Mirkin et al. ('574) in view of Kotov teach the biologically active molecules are nucleic acids, but fail to teach them being antibodies.

Mirkin et al. ('371) teach that nucleic acids, antibodies and other specific protein binding proteins (col. 175) may be used in a similar device to provide for detection or protein analytes.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include in the function element of Mirkin et al. ('574) in view of Kotov, proteins instead of nucleic acids as taught by Mirkin et al. ('371), depending on whether detection of a protein analyte is detected.

### ***Response to Arguments***

3. Applicant's arguments filed 31 March 2009 have been fully considered but they are not persuasive.

Applicant argues that the methods of making polyelectrolytes of Kotov (LBL) and the instant claims (plasma polymerization) yield both structure and properties of polyelectrolyte layers that are different. Applicant argues that the final products are not the same due to the methodology by which the layer is formed.

4. Applicant's argument is not persuasive because nowhere in the rejected claims or the specification does applicant recite that the plasma layer with charged chemically reactive groups is formed by plasma polymerization. Furthermore, the instant

specification, at page 18, lines 12-15, teaches that a polyelectrolyte is a plasma layer with charged chemically reactive groups. According to MPEP 2113, "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Because the instant specification and the claims do not specifically teach that the plasma layer with charged chemically reactive groups is formed by plasma polymerization or that the claimed polyelectrolyte is irregular, applicant's argument is not persuasive. Therefore since the instant specification recites a polyelectrolyte by name, and Kotov et al. teach a polyelectrolyte by name, the polyelectrolyte of Kotov et al. reads on the instant claims.

5. Additionally, the rejected claims do not recite a product-by-process of a plasma layer formed by a plasma polymerization. Therefore, in response to applicant's argument that polyelectrolyte of Kotov et al. has a different structure and different properties as the claimed polyelectrolyte, it is noted that the features and product-by-process upon which applicant relies (i.e., formed by plasma polymerization and being highly irregular in structure) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's affidavit filed 31 March 2009 has been considered. Applicant argues that the polyelectrolyte layer taught by Kotov et al. has different structural properties than the claimed plasma layer with charged chemically reactive groups. Applicant argues that the polyelectrolyte layer taught by Kotov et al. is formed by LBL, which produces a layer having a well-ordered crystalline structure. Applicant further argues that the claimed plasma layer is formed by plasma polymerization which produces a highly irregular and amorphous structure.

Applicant's argument is not persuasive. It is noted that at page 18, lines 12-15, the instant specification teaches that a polyelectrolyte layer is one possible type of plasma layer with charged chemically reactive groups. Kotov et al. also teach a polyelectrolyte layer. Nowhere in the instant claims or specification is a process of forming plasma layer with charged chemically reactive groups by plasma polymerization recited or taught. Additionally, nowhere in the instant claims or specification is a plasma layer with charged chemically reactive groups having an amorphous structure recited or taught. Applicant's only teaching of the type of plasma layer with charged chemically reactive groups is the polyelectrolyte taught at page 18. Therefore applicant's argument is irrelevant to the instant claims and specification. The polyelectrolyte layer taught by Kotov et al. reads on the instant claims because the instant specification recites, by name, that a plasma layer with charged chemically reactive groups may be a polyelectrolyte, and the same layer is taught by name by Kotov et al.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELANIE YU whose telephone number is (571)272-2933. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Shibuya can be reached on (571) 272-0806. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melanie Yu/  
Patent Examiner, Art Unit 1641